

REMARKS/ARGUMENTS

Drawings Allowed

The Applicant notes the Examining Attorney has accepted the drawings and appreciates the same.

Claim Objections

The Examining Attorney has rejected claims 21 and 22 because of specific informalities.

The Applicant respectfully requests the Examining Attorney reconsider the rejection as claims 21 and 22 are being currently amended, as shown hereinabove.

Anticipation - Section 102(b) Rejection

The Examining Attorney has rejected claims 1-7, 11, 13-15 and 26 as being anticipated by Van Der Lely et al. (3,218,791). The Applicant respectfully requests the Examining Attorney reconsider the rejection based on the arguments set forth below.

The Examiner states that with regard to claims 5, 6, 14 and 15, the rotation frame is bias suspended from the framework, and cites to Figure 22 in support of that position. However neither Figure 22 nor the description related to Figure 22 in the specification, mention, describe or teach being bias suspended

or biased at all, as mounted to a framework. Therefore not all of the elements of the claims are disclosed in the reference and there is an insufficient basis to assert Section 102 and those claims should be allowed. There is only disclosure in Van Der Lely regarding the guard flexing or springing, and nothing about it being movable mounted relative to the framework to allow the entire rotation framework to move vertically or to be suspended in a biased manner such as with a spring, as disclosed and claimed in this invention.

There is no anticipation if the reference does not disclose each and every element of the claimed invention. SSIH Equipment S.A. v. United States International Trade Commission, 718 F.2d 365, 218 U.S.P.Q. 678 (1983).

The applicant submits that Van Der Lely et al. does not anticipate this invention for the following reasons:

1. Van Der Lely et al. is not known or capable of performing the function of this invention, nor does it teach the disclosure of this invention. Van Der Lely provides a “guard” and not a dampener, the guard being just that, a “guard” which deflects in a lateral or horizontal deflection, to expose or unmask the tool for use. This is shown for instance in Figure 2 where the shaded lines labeled with item 10 show how the “guard” 13 is deflected horizontally. Van Der Lely does not disclose a dampener at all, let alone a dampener which is mounted relative to the plurality of tines such as to determine the “depth” at which the “plurality of tines may penetrate into a ground surface”

There is no anticipation by a prior patent not known or recognized as being capable of performing the function of the patented device, but rather the prior patent must itself do the teaching. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 221 U.S.P.Q. 385 (1984); Edstrom-Carson & Co. v. Onsrud Machine Works, Inc., 129 U.S.P.Q. 457.

2. Van Der Lely et al. does not disclose the purpose, means or mechanism that this invention discloses. Van Der Lely provides a “guard” and not a dampener, the guard being just that, a “guard” which deflects in a lateral or horizontal deflection, to expose or unmask the tool for use. This is shown for instance in Figure 2 where the shaded lines labeled with item 10 show how the “guard” 13 is deflected horizontally.

There is no anticipation where a reference does not disclose the purpose, means and mechanism for accomplishing the instant invention but rather is restricted to a limited and different means. Sperry Products, Inc. V. Aluminum Company of America, 120 U.S.P.Q. 362.

3. Van Der Lely et al. does not solve the problems this invention solves; in that Van Der Lely solves a guarding problem so that items approaching from lateral direction are guarded against, and it is not until the guard is removed that the tool portion can operate. This invention addresses the problem of the depth of engagement of the tines, not the lateral guarding of the tines. There is no anticipation if a prior patent does not solve the problem(s)

which the subsequent patent successfully solves. Technical Development Corporation v. Servo Corporation of America, 125 U.S.P.Q. 133.

4. The Van Der Lely et al. reference does not disclose each and every element of the claimed invention, as required for a *prima facie* case of anticipation, and as stated more fully above. Van Der Lely does not disclose a dampener at all, let alone a dampener which is mounted relative to the plurality of tines such as to determine the “depth” at which the “plurality of tines may penetrate into a ground surface”

Regarding Claims 5 & 6:

The Examiner states that with regard to claims 5, 6, 14 and 15, the rotation frame is bias suspended from the framework, and cites to Figure 22 in support of that position. However neither Figure 22 nor the description related to Figure 22 in the specification, mention, describe or teach being bias suspended or biased at all, as mounted to a framework. Therefore not all of the elements of the claims are disclosed in the reference and there is an insufficient basis to assert Section 102 and those claims should be allowed.

There is no anticipation if the reference does not disclose each and every element of the claimed invention. SSIH Equipment S.A. v. United States International Trade Commission, 718 F.2d 365, 218 U.S.P.Q. 678 (1983).

Claims 7-10, 14 and 26

The Examining Attorney has also rejected claims 7-10, 14 and 26 as being anticipated by Wray, Sr. (2,532,652). The Applicant respectfully requests the Examining Attorney reconsider the rejection based on the arguments set forth below.

The Examiner states that with regard to claim 14 and 15, the rotation frame is bias suspended from the framework, and previously cited to Figure 22 in the Van Der Lely reference in support of that position. However neither Figure 22 nor the description related to Figure 22 in the specification, mention, describe or teach being bias suspended or biased at all, as mounted to a framework. Therefore not all of the elements of the claims are disclosed in the reference and there is an insufficient basis to assert Section 102 and those claims should be allowed. There is only disclosure in Van Der Lely regarding the guard flexing or springing, and nothing about it being movable mounted relative to the framework to allow the entire rotation framework to move vertically or to be suspended in a biased manner such as with a spring, as disclosed and claimed in this invention.

There is likewise no disclosure in Wray which provides for the bias mounting of the rotation framework is bias mounted relative to the framework to which it is mounted.

The applicant also and further submits that Wray, Sr. does not anticipate this invention for the following reasons:

1. Wray, Sr. does not disclose the purpose, means or mechanism that this invention discloses; Wray, Sr. does not provide a tine dampener to allow some penetration into the ground surface, but which controls the ground or soil surface. Instead in Wray the wheels and tires are not dampeners and Wray specifically states at Column 4, lines 10-15, that the tines are maintained spaced apart from the ground or soil. The Wray reference does not contemplate a dampening at all, but instead uses the wheels and tires as a spacer.

There is no anticipation where a reference does not disclose the purpose, means and mechanism for accomplishing the instant invention but rather is restricted to a limited and different means. Sperry Products, Inc. V. Aluminum Company of America, 120 U.S.P.Q. 362.

2. Wray, Sr. does not solve the problems this invention solves, for the reasons stated above. There is no anticipation if a prior patent does not solve the problem(s) which the subsequent patent successfully solves. Technical Development Corporation v. Servo Corporation of America, 125 U.S.P.Q. 133.

3. The Wray, Sr. reference does not disclose each and every element of the claimed invention, as required for a *prima facie* case of anticipation, and as stated more fully above. Wray, Sr. does not provide a tine dampener to allow some penetration into the ground surface, but which controls the ground or soil surface. Instead in Wray the wheels and tires are not dampeners and Wray specifically states at Column 4, lines 10-15, that the tines are maintained spaced

apart from the ground or soil. The Wray reference does not contemplate a dampening at all, but instead uses the wheels and tires as a spacer.

There is no anticipation if the reference does not disclose each and every element of the claimed invention. SSIH Equipment S.A. v. United States International Trade Commission, 718 F.2d 365, 218 U.S.P.Q. 678 (1983).

Obviousness - Section 103(a) Rejections

The Examiner has rejected claim 12 as being unpatentable over Van Der Lely in view of Johnson. Applicant requests the Examiner reconsider the rejection of claim 12 because there is nothing in the Van Der Lely et al. in view of Johnson (4,495,755).

For the reasons stated above with respect to anticipation, Van Der Lely does not include all the elements in this invention, and therefore the combination of Van Der Lely and Johnson, does not include all the elements of the rejected claims, and there is therefore no *prima facie* case of obviousness.

Furthermore, there is nothing in the Van Der Lely et al. in view of Johnson reference which suggests the desirability of the combination and therefore the Examiner has not met the minimum required showing for *prima facie* obviousness. There is no motivation to make the combination.

In the U.S. Court of Appeals for the Federal Circuit case of *In Re: Lee*, 61 U.S.P.Q. 2d 1430, decided January 18, 2002, the Federal Circuit held:

... Thus, when they rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record. The failure to do so is not consistent with either effective administrative procedure or effective judicial review. The Board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.

The examining attorney has therefore failed to meet the requirement to set forth with specificity the general knowledge in the art to enable a finding that the person having ordinary skill in the art would make such combination.

As the PTO recognizes in MPEP 2142:

The legal concept of *prima facie* obviousness is a procedural tool of examination which applies broadly to all arts. It allocates who has the burden of going forward with production of evidence in each step of the examination process.... The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of non-obviousness.... The initial evaluation of *prima facie* obviousness thus relieves both the Examiner and Applicant from evaluating

evidence beyond the prior art and the evidence in the specification as filed until the art has been shown to suggest the claimed invention.

MPEP 2143.01 provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re: Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

The Federal Circuit has several times expressly addressed the issue of how to evaluate an alleged case of *prima facie* obviousness to determine whether it has been properly made. Thus, *In re: Geiger* stated in holding that the PTO "failed to establish a *prima facie* case of obviousness:

Obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ADC Hospital Systems, Inc. V. Monteffore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

Claims 16 -25

The Examiner has rejected claims "16-25" as obvious when combining Van Der Lely in View of Tonutti. Applicant requests the Examiner reconsider the rejection of claims 16-25 based on the arguments submitted below and further because there is nothing in the Van Der Lely et al. in view of Tonutti (6,314,710).

For the reasons stated above with respect to anticipation, Van Der Lely does not include all the elements in this invention, and therefore the combination of Van Der Lely and Tonutti, does not include all the elements of the rejected claims, and there is therefore no prima facie case of obviousness. Claim 16 has been amended to specify that the first extension arm and the second extension arm are pivotally mounted at a frontward end to a side of the central base framework, which when combined with the other claim element that the rearward ends of the extension arms are extended and retracted, and not the frontward ends as shown in the Tonutti reference, sufficient distinguish this invention from the references. This argument applies to claims 16-26.

Furthermore, there is nothing in the Van Der Lely et al. in view of Tonutti reference which suggests the desirability of the combination or placing the pivot point for the extension arms in the frontward end, and therefore the Examiner has not met the minimum required showing for *prima facie* obviousness.

Claims 24 and 25.

Still further, there is nothing the office action which indicates whether or where the elements from claim 24 for instance are in the references, and

applicant submits it is allowable as well. Likewise, claim 25 does not coincide with claim 24 and the applicant does not see the basis in Examiner's argument relative to claims 16-24 that apply to claim 25, and submits for all the reasons and arguments contained herein, that it is allowable over the art.

In the U.S. Court of Appeals for the Federal Circuit case of *In Re: Lee*, 61 U.S.P.Q. 2d 1430, decided January 18, 2002, the Federal Circuit held:

... Thus, when they rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record. The failure to do so is not consistent with either effective administrative procedure or effective judicial review. The Board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.

The examining attorney has therefore failed to meet the requirement to set forth with specificity the general knowledge in the art to enable a finding that the person having ordinary skill in the art would make such combination.

As the PTO recognizes in MPEP 2142:

The legal concept of *prima facie* obviousness is a procedural tool of examination which applies broadly to all arts. It allocates who has the burden of going forward with production of evidence in each

step of the examination process.... The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of non-obviousness.... The initial evaluation of *prima facie* obviousness thus relieves both the Examiner and Applicant from evaluating evidence beyond the prior art and the evidence in the specification as filed until the art has been shown to suggest the claimed invention.

MPEP 2143.01 provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re: Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

The Federal Circuit has several times expressly addressed the issue of how to evaluate an alleged case of *prima facie* obviousness to determine whether it has been properly made. Thus, *In re: Geiger* stated in holding that the PTO "failed to establish a *prima facie* case of obviousness:

Obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ADC*

Hospital Systems, Inc. V. Monteffiore Hospital, 732 F.2d 1572, 1577,
221 USPQ 929, 933 (Fed. Cir. 1984).

Prior Art Made of Record and Not Relied Upon

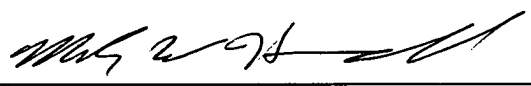
The Applicant notes the prior art made of record but not relied upon and asserts that for the reasons set forth above, the claims are allowable over the art made of record.

Conclusion

Applicant therefore submits Claims 1-26 are in a position to proceed to allowance.

Respectfully submitted,

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